

8<sup>3</sup> characteristics separate from the file image and the file images of a user-selected file, in response to user command for previewing that file.

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### REMARKS

Claims 1-17 are pending. Claims 1, 7 and 12 have been amended.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Windows NT Explorer 4.0 screen dumps Figs. 1-9, 1994 (hereinafter "Explorer") in view of PhotoImpact 3.0 file dialog box screen dumps 1996 (hereinafter "PhotoImpact").

The present invention provides a method and apparatus for previewing internal file characteristics and images in an operating system without requiring the opening of an application program in working memory. An extension coupled to an operating system is provided that is entirely integrated with the operating system and shares a user interface with the operating system. The extension avoids the costly load time and working memory required by applications programs.

The cited prior art, Windows NT Explorer 4.0 screen dumps and PhotoImpact 3.0 file dialog box screen dumps do not teach an extension integrated with the operating system enabling display of a recitation of indicia of internal file characteristics separate from the file image. As the Examiner states "Windows NT Explorer fails to explicitly disclose: an extension...enabling display of a recitation of indicia of internal file characteristics separate from the file image." PhotoImpact does disclose a display of file images and internal file characteristics, but PhotoImpact is an application program that is opened and loaded into working memory in order to display file images. PhotoImpact is not an extension coupled to an operating system.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), (MPEP 2143).

The cited prior art references (Explorer and PhotoImpact) lack a suggestion to combine the references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (MPEP 2143.01). The user interface screen dumps of Explorer and PhotoImpact do not even recognize the difference between an operating system extension and an application program. Without addressing this distinction they provide no suggestion to combine the references.

The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (MPEP 2143.01). The PhotoImpact reference does not suggest any modification in which PhotoImpact runs as an extension to the operating system. Neither does PhotoImpact suggest that its functionality (e.g., display of file images and internal file characteristics) could be combined with the Explorer extension in order to provide an extension for previewing file images and internal file characteristics that is entirely integrated with the operating system and shares a user interface with the operating system, as is claimed in the present invention.

Even if a motivation to combine the cited prior art references did exist, the combination lacks a reasonable expectation of success because neither of the cited prior art references address the inherent problems involved in converting an application program into an operating system extension. Application programs are loaded into working memory and also typically load object oriented programming controls (e.g., Microsoft OLE controls) to provide support for various user interface functionality. Loading and opening application programs is costly both in terms of memory used and time to perform the loading and opening operations.

The present invention recognizes the inherent limitations and distinctions between application programs and extensions coupled to operating systems. The present invention addresses these inherent limitations by teaching a sharing of a user interface with the operating system, thus avoiding the costly load time and working memory required by utilizing an applications program's user interface.

Independent Claims 1, 7 and 12 have been amended to recite the limitation "sharing a user interface with the operating system". Support for this amendment can be found at least at page 4, lines 8-11, page 6, lines 18-20 and in Figs 3A and 3C in the Specification as originally filed. Since all the limitations of amended Claims 1, 7 and 12 including "sharing a user interface with the operating system" are not taught, suggested or otherwise made obvious by a proper combination of the cited art (Explorer and PhotoImpact) amended Claims 1, 7 and 12 are believed to be patently distinguishable over the cited art. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 1, 7 and 12 under 35 U.S.C. 103(a).


Claims 2-6, 8-11 and 13-17 are dependent on amended base Claims 1, 7 and 12, respectively. The above remarks regarding amended Claims 1, 7 and 12 apply to dependent Claims 2-6, 8-11 and 13-17 by virtue of the fact that, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, Applicants respectfully request withdrawal of the rejection of Claims 2-6, 8-11 and 13-17 under 35 U.S.C. 103 (a).

#### CONCLUSION

In view of the above amendments and remarks, it is believed that all claims (1-17) are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 341-0036.

Respectfully submitted,

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MARKED UP VERSION OF AMENDMENTS

Claim Amendments Under 37 C.F.R. § 1.121(c)(1)(ii)

1. (Five Times Amended) In a computer system having (i) a working memory in which application programs are executed, and (ii) an operating system including a file manager for managing files of application programs executed in the working memory, internal file characteristics and file image preview apparatus comprising:

an extension coupled to the operating system in a manner such that the extension is entirely integrated with the operating system, the extension sharing a user interface with the operating system, the extension enabling user selection of a desired file and in response to user selection of the desired file, the extension enabling display of a recitation of indicia of internal file characteristics separate from the file image and the file image of the desired file by opening the desired file in a manner free of opening an application program in working memory and hence external to application programs in the working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file; and

a display assembly responsive to the extension for displaying the recitation of indicia of internal file characteristics separate from the file image and the file image of the user-selected desired file by opening the desired file in a manner free of opening an application program in working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file, such that a preview of the user-selected desired file is provided.

7. (Five Times Amended) In a computer system having (i) an operating system and (ii) a working memory for executing application programs, internal file characteristics and file image previewing apparatus comprising:

a file manager coupled to the operating system, including sharing a user interface with the operating system, the file manager (a) managing files generated by application programs executed in the working memory and (b) enabling display of indicia of internal file

characteristics and file image of a user-selected file by opening the desired file, said file manager being coupled to the operating system in a manner such that said display of indicia of internal file characteristics separate from the file image and the file image is generated outside of an application program opened and running in the working memory and hence external to application programs in the working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file; and

a display assembly responsive to the file manager for displaying indicia of internal file characteristics and the file image of the user-selected file by opening the desired file, outside of an application program opened and running in working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file, said display assembly thus providing a preview of the user-selected file.

12. (Five Times Amended) In a computer system, a method of displaying internal file characteristics and file images of a user-selected file, to provide a preview of the file, comprising the steps of:

providing a working memory for executing application programs;

executing application programs in said working memory in response to user command, said execution of the application program generating files of the computer system;

providing operating system means for enabling display of indicia of internal file characteristics separate from the file image and the file images of a file selected by a user by opening the file, the operating system means sharing a user interface with other operating system means and enabling display of the internal file characteristics and the file images outside of an application program opened and running in the working memory; and

in a manner free of opening and running an application program in the working memory, and in a manner free of decoding the [indication] indicia of internal file characteristics from a filename of the desired file, displaying the indicia of internal file characteristics separate from the file image and the file images of a user-selected file, in response to user command for previewing that file.